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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,065	11/08/2005	Hirofumi Bando	125721	6045
25944 7590 11/10/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
USELDING, JOHN E				
ART UNIT		PAPER NUMBER		
1796				
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11/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/556,065

**Applicant(s)**

BANDOH ET AL.

**Examiner**

JOHN USELDING

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8, 10 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 10-10, and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 10-13, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Yuasa et al. (WO 03/091180).

Regarding claim 8: Yuasa et al. teach all of the limitations related to compound A. They teach compounds resulting from the addition of 0 to 8 moles of an alkylene oxide containing 2 to 4 carbon atoms to each mole of the sum of the amino groups of a polyamide polyamine obtained by reacting 1.0 mole of polyalkylene polyamine with 0.8 to 0.95 mole of a dibasic acid or and ester of a dibasic acid with an alcohol containing 1 to 4 carbon atoms, and 0.05 to 0.18 mole of methacrylic acid with an alcohol containing 1 to 4 carbon atoms (page 65, line 32 to page 66 line 11). Yuasa et al. teach compounds B (page 37, lines 11-30), C, and D (page 28, line 11 to page 30, line15).

Regarding compounds C and D: Yuasa et al. teach that it is possible to combine a monomer of their formula (3) having an average molar number of addition in the range of 40 to 300 with a monomer (3) having the range of 2 to 40 (page 30, lines 7-10). Yuasa et al. teach mole ratios that meet the applicants  $y/(1-x)$  values (page 67, lines 29-34). Furthermore the values of  $y/(1-x)$  of the polyamide polyamine monomers

particularly disclosed in the production examples are also in the range of the applicants invention (production examples 16 and 17). Yuasa et al. teach mixing ratios for their copolymer (page 64, line 33 to page 65, line 10).

What Yuasa et al. fails to teach is the same mixing ratio of compounds A, B, C, and D. However, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to optimize the mixing ratio of the monomers for enhancing the water reducing capability and for obtaining an adequate viscosity. See MPEP 2144.05.

Regarding claim 10: Yuasa et al. also teach the use of antifoaming agents (page 89, line 7 to page 90, line 14) and air-entraining agents (page 90, line 18).

Regarding claims 11-13 and 16: Yuasa et al. teach that their dispersant is used in making ultrahigh strength concrete compositions (page 2, lines 16-18 and page 83, lines 15-18).

### ***Response to Arguments***

Applicant's arguments filed 8/15/2008 have been fully considered but they are not persuasive.

Applicant has made the argument that Yuasa teaches C or D not C and D combined. This is not persuasive because as stated in the previous office action and above that Yuasa specifically teaches combining compounds that meet the limitations of C and D together (page 30, lines 7-16). Just because something is not necessitated does not mean it is not taught by the prior art. Disclosed examples and preferred

embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Furthermore, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed..." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See MPEP 2123.

The applicant has made the argument that Yuasa is directed toward high-strength concrete and not ultra-high strength concrete. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ultra-high strength concrete) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also, as stated in the previous office action, Yuasa teaches using their dispersant in ultrahigh strength concrete compositions (page 2, lines 16-18 and page 83, lines 15-18).

The applicant has made the argument that Yuasa had not contemplated optimizing the monomers used to change the viscosity. It would be obvious to one of ordinary skill in the art to modify the amount used for a desired viscosity. It is a result effective variable. See MPEP 2144.05. The applicant has provided no evidence of unexpected results.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN USELDING whose telephone number is (571)270-5463. The examiner can normally be reached on Monday-Thursday 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

John Uselding  
Examiner  
Art Unit 1796